APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,274	11/25/2003	Peter J. Ford	884A.0025.U1(US)	2959

29683   7590   06/22/2010
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EXAMINER
ELCENKO, ERIC J

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
06/22/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _19 March 2010_.
2a) ☐ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-41_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-5, 8-14, 16-29 and 31-41_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments have been considered but are moot in view of the new

ground(s) of rejection.

Claim Rejections - 35 USC § 101

Claims 28 and 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. The claims recite "a computer readable medium...", and there is nothing in

the specification specifically excluding transitory mediums from the claims computer readable medium.

Further, the USPTO Official Gazette from week #8 of 2010 (Feb 23, 2010), Volume 1351 page 212

specifically explains that the addition of the term "non-transitory" before the computer readable medium

will alleviate any issues with 35 USC 101 rejections, since the claims would no longer cover non statutory

subject matter. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   Claims 1-5, 8-14 and 16-19 are rejected under 35 U.S.C. 102(e) as being

anticipated by Le et al. (U.S Pub. No. 2004/0072585).

In regard to Claim 1 and corresponding Claim 12, Le teaches a terminal of a first party participating in a telephone call to a second party in the telephone call, (*cellular communication call, voice call, Para 1, 23, 27*)

using the stored identifier to determine automatically a destination address for a data message; (*the terminal identifies the person attempting to call from the caller identification data accompanying a call received and automatically sends the sms message to that number, Para 27*)

controlling a transmitter to send during the telephone call a data message with an automatically determined address wherein said transmitter is controller to send said data message out of band relative to the telephone call.; (*the user may wish to send an SMS during a voice call, the user enters a command on his keypad to choose and send a message to the other user, to send an SMS message when a call is already set up. Para 23, 27*)

In regard to Claims 2 and 13, Le teaches wherein the call is initiated at the terminal of the first party and storing the identifier data comprises storing the destination of the telephone call. (*an address field, from a first radio terminal to a recipient radio terminal, the address field of the SMS message being filled automatically from stored identification data, Para 27-30*)

In regard to Claim 3,5, 14 Le teaches wherein the telephone call is a circuit switched telephone call and the identifier data is the telephone number of the second party. *(the recipient telephone numbers, Para 27-30)*

In regard to Claim 4, Le teaches wherein the telephone call is terminated at the terminal of the first party and storing identifier data comprises storing the origin of the telephone call. (*the identification number identifies the other caller from caller identification data accompanying the call, Para 27*)

In regard to Claims 8 and 16, Le teaches wherein a database of contact information stored in the terminal issued to associate the identifier data with at least one contact address of the second party. (*the identification of the last few callers are stored in a list in the terminal, Para 29-30*)

In regard to Claims 9, 17, 26, 32 Le teaches where the destination address is any one of: an email address, a telephone number, a Bluetooth device address. (*phone numbers, Para 27-28*)

In regard to Claims 10-11 and 18-19, Le teaches controlling a display to provide temporarily during the telephone call, a user selectable option to transfer data to the other party participating in the telephone call without user specification of a destination address. (*Te user is prompted to choose said recipient terminal from a list of numbers stored automatically in the terminal using control means, Para 29*)

In regard to Claim 20, Le teaches a method comprising controlling a display to provide, while the telephone call is on-going, (*during a phone call, Para 23*)

a user selectable option to transfer data to another party participating in the telephone call without user specification of a destination address. (*sending a message comprising an address field from a first radio terminal to a recipient radio terminal the address field of said SMS message being filled in with the number of the recipient*

terminal, the terminal identifies the person from the caller identification data

accompanying the call received and automatically sends the SMS message to tat

number. Para 23, 27-30)

In regard to Claims 21-22, 31 and 35, Le teaches wherein selecting the provided

option enables user selection of one of a plurality of delivery mechanisms. (*the*

message is sent via an SMS message server, Para 27)

In regard to Claim 23, wherein controlling the display to provide comprises

controlling the display to provide more than one user selectable option to transfer data

to another party participating in the telephone call without user specification of a

destination address, wherein each option enables a different delivery mechanism. *t(he*

user selects from a list, whether to send to a single entity or multiple entities that are

selected from a user prompted list to send to without the need of specifying the

destination address, Para 28-30)

In regard to Claim 24, Le teaches further comprising automatically storing as a

consequence of the telephone call, data that identifies the second party, wherein

selecting a provided option enabled using the stored data to determine automatically a

destination address for a data message. (*the terminal identifies the person attempting to*

call from the call identification data accompanying the call and automatically sends the

message to that number. Para 27)

In regard to Claim 25, Le teaches comprising controlling a transmitter to send the

data message with the determined destination address. (*the terminal identifies the*

person calling and automatically sends the SMS message to that number, Para 27)

In regard to Claims 27 and 41, Le teaches wherein controlling a display to provide, while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call without user specification of a destination address temporarily augments automatically a user selectable data transfer option for transferring data to a user determined destination address. *sending a message comprising an address field from a first radio terminal to a recipient radio terminal the address field of said SMS message being filled in with the number of the recipient terminal, the terminal identifies the person from the caller identification data accompanying the call received and automatically sends the SMS message to tat number. Para 23, 27-30)*

In regard to Claim 28, Le teaches a memory and at least one processor the at least one memory and the computer program code configured to with the at least one processor, cause the apparatus to perform at least the following:, (*numbers stored in the terminal memory, Abs)*
to control a display to provide, temporarily while a telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call without user specification of a destination address. (*sending a message comprising an address field from a first radio terminal to a recipient radio terminal the address field of said SMS message being filled in with the number of the recipient terminal, the terminal identifies the person from the caller identification data accompanying the call received and automatically sends the SMS message to tat number. Para 23, 27-30)*

In regard to Claim 33 and corresponding Claim 34, Le teaches in a terminal of a first party, storing as a consequence of a communication between the first parry and a second party, identifier data that identifies the second party. (*the terminal identifies the person attempting to call from the caller identification data accompanying a call received and automatically sends the sms message to that number, Para 27*)

using the stored identifier data to determine automatically a destination address for a data message and controlling a transmitter to send a data message with the automatically determined destination address. (*the terminal identifies the person in the call from identification data and automatically sends the SMS message to that number, Para 27*)

In regard to Claim 39 and corresponding claim 40, Le teaches in a terminal of a first party participating in a telephone call, storing as a consequence of the telephone call, identifier data that identifies a second part participating in the telephone call, (*the terminal identifies the person attempting to call from the caller identification data accompanying a call received and automatically sends the sms message to that number, Para 27*)

using the stored identifier data to determine automatically a destination address for a data message and controlling a transmitter to send a data message with the automatically determined destination address. (*the terminal identifies the person in the call from identification data and automatically sends the SMS message to that number, Para 27*)

wherein said transmitter is controlled to send said data message via a new

channel that runs in parallel with the voice channel used for the telephone call. (*the*

message is an SMS message which is sent over a data channel using the messaging

service, Para 26-28)

4.   Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le

et al. (U.S Pub. No. 2004/0072585) in view of Paik et al. (U.S. Pub. No. 2008/0153471).

In regard to Claims 36-38, the combination does not directly disclose wherein

using the stored identifier to determine automatically the destination address comprises

interrogating a database using the stored identifier data to obtain the destination

address.

Paik teaches a caller identifier detecting unit which detects an identifier of an

originating mobile terminal, a control unit which controls storage of the caller identifier

information, and a caller identification generating unit. The identifier managing unit 45

manages the identifier of the respective mobile terminal in the form of a database under

the control of the control unit. (Para 45-47)

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the combination to include the teaching of Paik. One of ordinary skill

in the art could have combined the known prior art elements using known techniques to

yield predictable results to one of ordinary skill in the art of a database logging the caller

identifiers for a communication.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC ELCENKO whose telephone number is (571)272-8066. The examiner can normally be reached on M-F   7:30 AM through 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Elcenko/
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　　Supervisory Patent Examiner, Art Unit 2617